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OFFICE OF PETITIONS

In re Application of
Vandermeer
Application No. 10/005,881
Filed: 8 November, 2001
Attorney Docket No. BUN-8601

ON PETITION

This is a decision on the petition filed via FAX on 11 March, 2003, and resubmitted on 9 May, 2003, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.¹

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is
GRANTED.

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to Notice to File Missing Parts

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:
§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * * (Emphasis supplied.)

mailed on 4 January, 2002, with the reply due (absent extension of time) on or before 4 March, 2002;

- as a result, the application was deemed abandoned after midnight 4 March, 2002;
- no Notice of Abandonment was mailed before the instant petition was filed;
- Petitioner and Counsel (John A. Parrish (Reg. No. 31,918)) filed the instant petition under 37 C.F.R. §1.181 (with authorization for fee, which is waived), contemporaneously with copies of (*inter alia*):

--the Notice of Missing Parts and the response thereto in the form of a signed oath/declaration and authorization for credit card payment of fees (small entity) including the basic filing fee (\$375.00), 3 additional independent claims (\$126.00), and the surcharge (\$65.00);

--office records evidencing the non-receipt of the Notice of Missing Parts.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³ Delays in responding properly raise the question whether delays are unavoidable.⁴

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 4203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Petitioner has made an adequate showing of non-receipt.⁸

Accordingly, in view of the showing and statement of Counsel the petition to withdraw the holding of abandonment under 37 C.F.R. §1.181 hereby is **granted** and, as noted above, petition fees are waived.

The instant file is being forwarded to OIPE for further processing consistent with this decision, before being forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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⁵ See: In re Application of G., 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and or deposited for shipment.

⁸ See MPFP 711.03(c)(III)(C)(2).